



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/602,626

06/25/2003

Flora P. Goldthwaite

MFCP.101281

8980

45809

7590

07/21/2009

SHOOK, HARDY & BACON L.L.P.
(c/o MICROSOFT CORPORATION)
INTELLECTUAL PROPERTY DEPARTMENT
2555 GRAND BOULEVARD
KANSAS CITY, MO 64108-2613

EXAMINER

ABEDIN, SHANTO

ART UNIT

PAPER NUMBER

2436

MAIL DATE

DELIVERY MODE

07/21/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/602,626	Applicant(s) GOLDTHWAITE ET AL.	
	Examiner SHANTO M. ABEDIN	Art Unit 2436	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16, 19-24 and 26-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16 and 19-24 is/are allowed.
- 6) ☒ Claim(s) 26-37 and 39-45 is/are rejected.
- 7) ☒ Claim(s) 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/04/2009 has been entered.
2. Claims 16, 19-24 and 26-45 are pending in the application.
3. Claims 16 and 19-24 are allowed.
4. Claim 38 is objected.
5. Claims 26-37 and 39-45 have been rejected.

Response to Arguments

6. The applicant's arguments regarding objections to claims are fully considered, the previous objections to the claims are withdrawn because of the amendments made to the claims.
7. The applicant's arguments regarding 35 USC 112 first paragraph type rejections are fully considered, the previous 35 USC 112 first paragraph type rejections are withdrawn because of the amendments made to the claims.
8. The applicant's arguments regarding the previous 35 USC 101 type rejections of claims 26-31 are fully considered, however, found not persuasive. In particular, the amendments made to the claims 26-30 were unable to overcome the issues set forth by previous 35 USC 101 type rejections (please see below for detail explanations). Upon further examination, 35 USC 101 type rejections of claim 32 is withdrawn.

9. The applicant's arguments regarding the previous 35 USC 103(a) type rejections are fully considered, however, found not persuasive in respect to claims 26-37 and 39-45. In particular, combination of the previously cited references was found to teach the limitations set forth by the amended claims 26-37 and 39-45 (please see the rejections below). The examiner notes, upon further consideration, the previous 35 USC 103(a) type rejections of claims 16, 19-24 and 38 are withdrawn.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 26-30 are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 26-30, they are directed to a system comprising plurality of the components, however, although preamble of the claim set recite "a system having a processor and memory", the actual claim limitations failed to disclose any associated computer hardware/ structures or devices, and it is not clear what the applicant is trying to claim by 'having' – is memory and processor communicative to the claimed system, or associated with claimed system, or actual component of such system?

Claimed features such as a service, permission control, and preference control could optionally be implemented in software only. In particular, the specification discloses claimed features can be implemented as a part of the program modules or application program (please see Par 0023). Although the claim languages recite a service or control utilizing the processor and memory, what actually claimed is a service or control, not the processor or memory!

Therefore, claims are rejected under 35 USC 101 because of being non-statutory as the claimed invention fails to disclose expressly any hardware, memory or processor as a component of it. See MPEP 2106.01

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 26-27 and 29-31 are rejected under 35 USC 103 (a) as being unpatentable over Allen et al (Pub US 2002/0149705 A1) in view of Balasuriya (US 2003/ 0041048 A1) further in view of Heatley (US 7164936 B2)

Regarding claim 26, Allen et al teaches a system for allowing a user having a unique identity to manage communications, wherein the unique identity is associated with a plurality of electronic devices, the system comprising:

a service, wherein an authorized identity can access the user's unique identity to communicate with the user only by using the unique reference (Par 065, 093; accessing a unique address, or caller ID/ telephone number associated with the contacts are needed to initiate the communication between the contacts and users);

permission controls for allowing the user to control access to the unique identity by restricting authorization to a selected set of other identities which includes the authorized identity (Par 092- 094;

user selecting/ controlling desirable communication devices/ addresses, and methods as a part of the creating contacts or identifiers); and

preference controls for allowing the user to select at least one associated device from a plurality of devices associated with the user, the at least one device is selected for receiving communication upon an access attempt by an authorized user (Par 034, 043, 092-094; user selecting/ controlling desirable devices/ addresses associated with the selected contacts).

Allen et al fails to disclose a service for generating a reference to a user's identity; and for assigning a reference to a user's unique identity such that the unique reference is a pointer to the user's unique identity.

However, Balasuriya discloses a service for generating a reference to a user's identity (par 023, 028, 036-037; deriving caller identity/ id based on phone number, IP address, or device information). Balasuriya further discloses allowing the user to control access to the unique identity by restricting authorization to a selected set of other identities (par 023-028, 036-037; restricting/ permitting communication based upon subscriber/ user, and/ or device's status and identities). Furthermore, Heatley discloses a service for generating a reference to a user's identity; and for assigning a reference to a user's unique identity such that the unique reference is a pointer to the user's unique identity (Fig 3; Col 5, starts at line 60; references associated with user identifier/ profile). Heatley further discloses preference controls for allowing the user to select at least one associated device from a plurality of devices associated with the user, the at least one device is selected for receiving communication upon an access attempt by an authorized user (Col 4, starts at line 55; user preferences)

Heatley, Balasuriya and Allen et al are analogous art because they are from the same field of endeavor of managing communication. At the time of invention, it would have been obvious to a

Art Unit: 2436

person of ordinary skill in art to combine the teaching of Heatley and Balasuriya with Allen et al to design a method comprising allowing the user to control access to the unique identity by restricting authorization to a selected set of other identities in order to prevent unauthorized user access.

Regarding claim 27, Allen et al teaches the system wherein the service is a centralized service comprising a directory for allowing system users to locate references for other system users (Par 064-065; list or directories of caller ID/ telephone number associated with the contacts).

Regarding claim 29, Allen et al teaches the system wherein the preference controls comprise tools for allowing selection of a communication reception mode and a communication transmission mode, wherein the communication reception and the communication transmission mode comprise at least audio and text modes (Par 063, 092, 094, 104; communication methods associated with different users.)

Regarding claim 30, Allen et al teaches the system further comprising translation services for translating from a communication transmission mode to a communication reception mode (Par 063, 092, 094; communication modes).

Regarding claim 31, Allen et al teaches the system wherein the plurality of associated devices comprise at least a telephone and a personal computerized device (Par 064-065, 094; plurality of communication devices).

Art Unit: 2436

12. Claims 32-37 and 39-45 are rejected under 35 USC 103 (a) as being unpatentable over Allen et al (Pub US 2002/0149705 A1) in view of Burgess (US 6359970 B1) further in view of Heatley (US 7164936 B2)

Regarding claim 32, Allen et al discloses a method for managing electronic communications directed to an identity owner by way of an identity owner account, wherein the identity owner account is associated with a plurality of electronic devices of the identity owner, the method comprising;

receiving, from the identity owner, an indication of a user that is authorized to communicate with the identity owner; and wherein the plurality of electronic devices to facilitate the users' communication to the identity owner (Fig 6, Fig 7; Par 060, 063-066, 091-093, 101; communication selection component, or contact entry component allowing the users to select a set of 'contact' that users want to communicate with; contacts are associated with the specific devices/ addresses);

storing, the authorization of the user to communicate with the identity owner (Fig 6, Fig 7; Par 060, 063, 066, 093, 101; storing desired contact information);

receiving, from the identity owner, an indication as to which of the plurality of electronic devices are allowed to be utilized in the conveyance of a communication from the user regardless of a communication mode utilized by the user to establish the communication (Par 0022, 0034, 0043, 0066, 0092; allowing users to select suitable/ desirable device to communicate with the contacts);

storing, the indication as to which electronic devices are allowed to convey a communication from the user (Fig 6, Fig 7; Par 060, 063, 066, 093, 101; storing desired contact/ communication device information); and

generating a unique reference that is the only reference useable by the user to access the identity owner in order to communicate with the identity owner; and wherein a communication from the user is routed to the identity owner according to the stored indication as to which electronic devices are allowed to convey a communication from the user (Par 065, 093; a unique address, or caller ID/telephone number associated with the contacts are needed to initiate the communication between the contacts and users).

Allen et al fails to disclose expressly wherein the user establishes communication with the identity owner by way of the identity owner account, and wherein the identity owner account utilizes the plurality of electronic devices to facilitate the users' communication to the identity owner; storing, in the identity owner account, the indication as to which electronic devices are allowed to convey a communication from the user; generating a unique reference that is the only reference useable by the user to access the identity owner account in order to communicate with the identity owner, wherein accessing the identity owner account is the only way for the user to establish a communication with the identity owner.

However, Burgess teaches storing, in the indication as to which electronic devices are allowed to convey a communication from the user; and the user to access the identity owner information in order to communicate with the identity owner (Col 7, starts at line 50; Col 12, starts at line 45; communication control; caller ID components)

Furthermore, Heatley teaches wherein the user establishes communication with the identity owner by way of the identity owner account, and wherein the identity owner account utilizes the plurality of electronic devices to facilitate the users' communication to the identity owner (Fig 3; Col 4, starts at line 50; user account with HLR, home location register; user preference, allowed equipments) ;

Art Unit: 2436

storing, in the identity owner account, the indication as to which electronic devices are allowed to convey a communication from the user; generating a unique reference that is the only reference useable by the user to access the identity owner account in order to communicate with the identity owner, wherein accessing the identity owner account is the only way for the user to establish a communication with the identity owner (Fig 3; Col 4, starts at line 50; Col 5, starts at line 59; references; user preference, allowed equipments).

Burgess , Heatley and Allen et al are analogous art because they are from the same field of endeavor of managing communication. At the time of invention, it would have been obvious to a person of ordinary skill in art to combine the teaching of Burgess and/ or Heatley with Allen et al to design a method wherein the user establishes communication with the identity owner by way of the identity owner account, and generating a unique reference that is the only reference useable by the user to access the identity owner account, and wherein accessing the identity owner account is the only way for the user to establish a communication with the identity owner in order to control users' communication preferences in an anonymous, and centralized manner.

Regarding claim 33, Allen et al discloses the method further comprising maintaining a look-up table for locating unique references at the request of a system user (Par 065; caller ID; telephone number). Furthermore, Burgess discloses the method further comprising maintaining a look-up table for locating unique references at the request of a system user (Col 8, starts at line 30; lookup table).

Regarding claim 34, Allen et al discloses the method further comprising providing preference controls for allowing an identity owner to select default methods for receiving communications from

Art Unit: 2436

the user (Fig 5; Par 066, 091-093; contact containing communication device information/ address; selecting contacts and associated device addresses).

Regarding claim 35, Allen et al discloses the method wherein the receiving an indication as to which of the plurality of electronic devices are allowed to be utilized in the conveyance of a communication from the user includes an indication for two or more electronic devices (Par 022, 034, 043, 066, 092; allowing users to select suitable/ desirable device to communicate with the contacts). Furthermore, Heatley discloses the method wherein the receiving an indication as to which of the plurality of electronic devices are allowed to be utilized in the conveyance of a communication from the user includes an indication for two or more electronic devices (Col 4, starts at line 50; Col 5, starts at line 59; user preference, allowed equipments)

Regarding claim 36, Allen et al discloses the method comprises allowing the identity owner to select a live communication delivery method (Par 093-094, 104; interactive television/ videoconferencing; address associated with the interactive television/ videoconferencing system). Furthermore, Heatley discloses allowing the identity owner to select a live communication delivery method (Col 4, starts at line 50; Col 5, starts at line 59; user preference; delivery mode selection)

Regarding claim 37, Allen et al discloses the method wherein the method comprises allowing the identity owner to select a message communication delivery method (Par 063, 092-094; plurality of types of reception devices/ addresses associated with the plurality of the communication methods/ systems).

Regarding claim 39, Allen et al discloses the method wherein the method comprises allowing selection of a live communication delivery method for a first group of users and a message communication delivery method for a second group of users (Par 063, 092-094; plurality of types of reception devices/ addressess associated with the plurality of the communication methods/ systems such as e-mail, text messaging, or interactive television/ videoconferencing).

Regarding claim 40, Burgess discloses the method further comprises allowing the identity owner to block communication delivery from a third group of individuals (Col 7, line 25 to Col 9, line 67; setting priority data; blocking)

Regarding claim 41, Allen et al discloses the method further comprising providing the identity owner with a pointer as the associated reference (Par 065; caller ID associated with the contacts). Furthermore, Heatley discloses the method further comprising providing the identity owner with a pointer as the associated reference (Fig 3; Col 6, starts at line 5; reference to the user/ identifier)

Regarding claim 42, Allen et al discloses the pointer to reference a plurality of electronic devices accessible to the identity owner (Par 065; caller ID associated with the contacts; Par 091-093; contact containing communication device information/ address)

Regarding claim 43, Allen et al discloses the method further comprising allowing transmission of a communication from the user in a first mode and delivery of the communication to the identity owner in a second mode (Par 063, 092-094; plurality of types of reception devices/ addresses

Art Unit: 2436

associated with the plurality of the communication methods/ systems such as e-mail, text messaging, or interactive television/ videoconferencing).

Regarding claim 44, Allen et al discloses the method further comprising translating the communication from the first mode to the second mode (Par 094; device configured to convert/ reproduce the messages). Furthermore, Heatley discloses translating the communication from the first mode to the second mode (Col 5, starts at line 60; message conversion)

Regarding claim 45, Allen et al discloses the method wherein the first mode and the second mode comprise one of voice communications, text communications, and video communications modes (Par 063, 092-094; plurality of types of reception devices/ addresses associated with the plurality of the communication methods/ systems such as e-mail, text messaging, or interactive television/ videoconferencing).

13. Claim 28 is rejected under 35 USC 103 (a) as being unpatentable over Allen et al (Pub US 2002/0149705 A1) in view of Balasuriya (US 2003/ 0041048 A1) further in view of Heatley (US 7164936 B2) further in view of Burgess (US 6359970 B1)

Regarding claim 28, it is rejected applying as above applied rejecting claim 26, Furthermore, Allen et al discloses providing live and message communication delivery options, and the permission controls further comprise tools for restricting a communication delivery method to one of live, message (Par 063, 092-094; plurality of types of reception devices/ addresses associated with the plurality of the communication methods/ systems). Furthermore, Heatley discloses the permission controls further

Art Unit: 2436

comprise tools for restricting a communication delivery method to one of live, message (Col 4, starts at line 50; Col 5, starts at line 59; user preference; delivery mode selection).

Modified Heatley- Balasuria- Allen method fails to disclose blocked communication delivery options, or blocking communication delivery from system user.

However, Burgess discloses the method/ system further comprises blocked communication delivery options, or blocking communication delivery from system user (Col 7, line 25 to Col 9, line 67; setting priority data; blocking).

Burgess and Allen et al are analogous art because they are from the same field of endeavor of managing communication. At the time of invention, it would have been obvious to a person of ordinary skill in art to combine the teaching of Burgess with modified Heatley-Balasuriya- Allen et al method/ system to design a mechanism comprising blocked communication delivery options, or blocking communication delivery from system user in order to provide user with the options of unauthorized call blocking.

Allowable Subject Matter

14. Claims 16 and 19-24 are allowed.

15. Claim 38 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

16. **Examiner's note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well.

Art Unit: 2436

It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

17. A shortened statutory period for response to this action is set to expire in 3 (Three) months and 0 (Zero) days from the mailing date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C 133, M.P.E.P 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shanto M Z Abedin whose telephone number is 571-272-3551. The examiner can normally be reached on M-F from 8:30 AM to 6:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moazzami Nasser, can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. The RightFax number for faxing directly to the examiner is 571-273-3551.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shanto M Z Abedin

Examiner, AU 2436

/Nasser G Moazzami/

Application/Control Number: 10/602,626

Page 15

Art Unit: 2436

Supervisory Patent Examiner, Art Unit 2436